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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,903	10/27/2000	Brigitte Weston	514412-2020.1	8217
20999	7590	11/18/2004		
FROMMERM LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER	KUBELIK, ANNE R
			ART UNIT	PAPER NUMBER
				1638

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/698,903	WESTON ET AL.
<b>Examiner</b>	<b>Art Unit</b>	
Anne R. Kubelik	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 26 August 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 24,25,30-32,38 and 43-49 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 24-25, 30-32, 38, 43, 47-49 is/are rejected.

7)  Claim(s) 44-46 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

### **DETAILED ACTION**

1. Claims 24-25, 30-32, 38 and 43-49 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Proposed amendment to the claims, limiting the primer sizes to 21-23 nucleotides long, which would have made the claims allowable, were faxed to Applicant's representative Anne-Marie Yvon on 12 November 2004. However, these examiner's amendments were not accepted.
4. The rejection of claims 24-26, 30-32 and 34-42 under 35 U.S.C. 112, first paragraph, for new matter is withdrawn in light of applicant's amendment or cancellation of the claims.
5. The rejection of claims 37-42 are rejected under 35 U.S.C. 112, first paragraph, for new matter is withdrawn in light of applicant's amendment or cancellation of the claims.
6. The rejection of claims 24-26, 30-32 and 34-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention is withdrawn in light of applicant's amendment or cancellation of the claims.

### ***Claim Objections***

7. Claim 48 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The kit of claim 48 fails to further limit the kit of claim 30; both

kits comprise only primers. The primers do not differ according to what kind of plant material the primers are used on. It is noted that the plant material is not part of the kit.

***Claim Rejections - 35 USC § 112***

8. Claims 24-25, 30-32, 38, 43 and 47-49 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of identifying elite event MS-B2 in transgenic Brassica or confirming seed purity using TAIL-PCR and primers SEQ ID NOS:4-7 and 9 or PCR using SEQ ID NOS:11-12 or 13-14, does not reasonably provide enablement for a method of identifying elite event MS-B2 in transgenic Brassica or confirming seed purity using PCR with any primer or using any other hybridization method. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The rejection is repeated for the reasons of record as set forth in the Office action mailed 26 August 2004, as applied to claims 24-26, 30-32 and 34-42. Applicant's arguments filed 18 February 2004 have been fully considered but they are not persuasive.

Applicant urges that the claims have been amended to emphasize that the PCR is performed with MS-B2 specific primer pairs and that the product is MS-B2 specific (response pg 8-9).

This is not found persuasive. Only primers between 21-23 nucleotides are exemplified. The specification does not teach other primers that specifically amplify MS-B2 event DNA, as opposed to other DNA in the Brassica genome. The specification does not provide guidance for primers within the full scope of the claims.

Applicant urges that specific portions of SEQ ID NOS:8 and 10 are now recited that that claims directed to a DNA molecule encoding the protein of SEQ ID NO:X are frequently granted; thus, claims to a very large genus are granted (response pg 9).

This is not found persuasive. Because DNA codons are known, every DNA that encodes a protein of SEQ ID NO:X will function. However, not all “consecutive nucleotides”, which includes 2-nucleotide long sequences, of SEQ ID NOS:8 or 10 will function as PCR primers to amplify an MS-BS specific DNA fragment. The specification must them teach which ones will function. The only ones that the specification teaches are 21-23 nucleotides long.

9. Claims 24-25, 30-32, 38, 43 and 47-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is repeated for the reasons of record as set forth in the Office action mailed 26 August 2004, as applied to claims 24-26, 30-32 and 34-42. Applicant's, in the respeonse filed 18 February 2004, did not address this rejection.

10. Claims 44-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne R. Kubelik, Ph.D.  
November 15, 2004



ANNE R. KUBELIK  
PATENT EXAMINER